

REMARKS

The Office Action and cited references have been reviewed. Claims 1-22 are rejected and remain pending. Claims 1, 7, 15-16, and 22 have been amended. Support for the amendments is found generally within the application and as specifically noted below. No claims have been cancelled and no new claims have been added. Consideration of the pending claims is respectfully requested.

Objection to Drawings

The Office Action objected to the drawing figures under 37 C.F.R. §1.84(p)(5). In particular, the Office Action indicated that the reference number 88 was shown in the drawings but not mentioned in the specification. Paragraph [0022] of the specification has been amended to include “nut 88.” Therefore, it is respectfully requested that the objection to the drawings be removed. No new matter has been entered or added.

Rejection of Claims under 35 U.S.C. §112

The Office Action has rejected claims 16-19 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Claim 16 has been amended to more clearly define the invention. As amended, claim 16 now recites, *inter alia*, “a valve actuator arranged to open the valve closure element in response to vacuum pressure.” In light of the claim amendment, it is respectfully requested that the rejection be withdrawn.

Rejection under 35 U.S.C. §103

The Office Action has rejected claims 1-5, 7-12, 15-20 and 22 under 35 U.S.C. §103(a) as being unpatentable over the Suntec Model PRV-38 literature (hereinafter “Suntec”) in view of U.S. Pat. App. No. 2,932,400 to Scavuzzo (hereinafter “Scavuzzo”). Each of claims 1, 7, 15 and 22 have been amended to more clearly define the invention and present the claims in better form for consideration. Reconsideration of the rejection in view of the amendments, as explained below, is requested.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142-2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As amended, claim 1 recites, *inter alia*, that "the inlet port is in fluid communication with the filter head exit port such that fluid can flow from the inlet port to the filter head exit port when the filter is not mounted and nothing is mounted on the filter mounting stub." This language defeats the asserted rationale and teaching for combining the references and exemplifies what the Applicants see as improper hindsight. Considering the basis for combining the references can no longer be sustained in view of the amendment, Applicants request the obviousness rejections be withdrawn.

In addition, Suntec does not teach or suggest the above noted limitation and Scavuzzo does not cure that deficiency. As clearly shown in FIGS. 1 and 2 of Scavuzzo, when the casing (12) is removed, the annular valve (40) is biased downwardly against the sleeve (16). As a result, any flow of fluid through slot (37) is terminated and fluid communication between the inlet (23) and the slot (37) is lost. Therefore, it is respectfully submitted that Suntec in combination with Scavuzzo fails to teach each and every limitation of claim 1 as amended.

Claims 2-5 depend from and include the limitations of claim 1 and are believed to be patentable for the reasons stated above for claim 1. Therefore, it is respectfully requested that the rejection of claims 2-5 be withdrawn.

Similarly to claim 1, each of independent claims 7, 15, and 22 have also been amended to recite that the inlet port is in fluid communication with the filter head exit port such that fluid can flow from the inlet port to the filter head exit port when the filter is not mounted and nothing is mounted on the filter mounting stub. Therefore, for the same reasons as stated above for claim 1, each of the independent claims 7, 15, and 22 are believed to be patentable. It is respectfully requested that the rejection of claims 7, 15, and 22 be withdrawn.

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Claims 8-12 depend from and include the limitations of claim 7 and are believed to be patentable for the reasons stated above for claim 7. Therefore, it is respectfully requested that the rejection of claims 8-12 be withdrawn.

Claims 16-20 depend from and include the limitations of claim 15 and are believed to be patentable for the reasons stated above for claim 15. Therefore, it is respectfully requested that the rejection of claims 16-20 be withdrawn.

The Office Action has also rejected claims 6, 13-14, and 21 under 35 U.S.C. §103(a) as being unpatentable over the Suntec in view of U.S. Pat. App. No. 6,471,853 to Moscaritolo (hereinafter “Moscaritolo”). In light of the amendments to each of claims 1, 7, and 15 as noted above, from which claims 6, 13-14, and 21 variously depend, it is respectfully submitted that this rejection is now moot and should be withdrawn.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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